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7590	10/03/2003		EXAMINER	
Tzvi Hirshaut Esq Cohen Pontani Lieberman & Pavane 551 Fifth Avenue Suite 1210 New York, NY 10176			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/688,482	LIBERMAN, BARNET L.
	Examiner	Art Unit
	Andrew J. Fischer	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 September 2003.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9 and 18-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### *Acknowledgments*

1. This application is a continuation-in-part (“CIP”) of Application No. 09/587,201 filed June 5, 2000.
2. The amendment filed September 12, 2003 (part of Paper No. 6) is acknowledged. Accordingly, claims 1-20 remain pending.

### *Restriction*

3. Applicant's election of Group I (claims 1-9) in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 10-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6.

### *Information Disclosure Statement*

5. The information disclosure statement (“IDS”) filed January 2, 2001 (Paper No. 3) fails in part to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP §609 because Applicant has not provided the date of publication. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that

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the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP §609 C(1).

6. The Examiner has considered the dates listed in Applicant's submitted PTO Form 149 (Paper No. 4) as the dates of publication (e.g. Reference 'AK' will be considered to have been published on November 10, 2000 which is after the filing date of this application).

7. Although the IDS noted above states "Page -1- of 2, the Examiner is unable to locate page 2. Appropriate correction is required.

***Drawings***

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

- a. The "after looping the first end" as recited in claim 3.
- b. The "receiving by the customer" as recited in claim 4.
- c. The "looping a second securing means" as recited in claim 5.

9. The Examiner notes the claims are replete with the above drawing errors. All method steps recited in claim 1-9 and 18-20 are clearly not shown in the drawings. The Examiner highly

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recommends Applicant review all 12 claims to ensure that all method steps and all structural details claimed are shown in the drawings. To show no new matter is found in the drawings, the Examiner respectfully requests Applicants to explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The limitation of “by the customer” specifically limits the claim to a particular human (i.e. a customer as opposed to an employee). A claim directed to or including within its scope a human being or attributes of a human being is not patentable subject matter.

See MPEP §2105 and 1077 OG 24 (April 21, 1987).<sup>1</sup>

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<sup>1</sup> “If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.” MPEP §2105.

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12. Claims 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. See MPEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

If Applicant expressly states which of the four §101 categories<sup>2</sup> Applicant intends his claims to be drawn to, this rejection might be withdrawn.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not disclosed how one of ordinary skill in the art would maintain a desired temperature by feeding a chilled gas into at least a portion of the tote.

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<sup>2</sup> 35 U.S.C. §101 defines four (4) categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” (or products) while the first category defines “actions” (i.e., inventions that consist of a series of steps or acts to be performed).

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15. If Applicant expressly admits on the record that such procedures are old and well known in the art and provides appropriate evidence in support thereof (i.e. a U.S. Patent), this particular rejection will be withdrawn.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 4, 8, 9, and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In claim 4, the limitation of “by the customer” specifically limits the claim to a particular human. See §101 rejections above.

b. In claim 8, it is unknown what objects are needed to perform the claimed step of “feeding a chilled gas into at least a portion of the tote . . .”

c. In claim 9, it is unclear if “a cover” as recited in line 5 is the same or different from “a cover” as recited in claim 1, line 3. Appropriate correction is required.

d. Claims 18-20 are indefinite since the scope of the claim is unclear.

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***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in-  
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

19. Claims 1-9 and 18-20, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Lipowsky et. al. (U.S. 2,159,279) ("Lipowsky"). Lipowsky discloses placing a grocery item (bread) in a tote (bread bag); delivering the tote to a destination (inherent); and securing the tote substantially at the delivery destination; an insulated bag the (inner bag); and the ordered grocery item requires refrigeration, and maintaining the grocery item at a desired chilled temperature (inherent in maintaining the bag at the ambient temperature).

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***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1-9 and 18-20, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sone in view of Lipowsky. Sone discloses dispatching a vehicle to deliver a grocery item.

Sone does not directly disclose a bag to store the delivered bread. Additionally, the Examiner takes Official Notice that frozen inserts are used to keep foods cold. Moreover, Lipowsky teaches storing the bread in the described bag. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone as taught by Lipowsky and include Lipowsky's storage bag. Such a modification would have helped prevent the bread or goods from becoming wet and moldy.

22. It is the Examiner's factual determination that all limitations in claims 1-9 and 18-20 have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and

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quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

23. After careful review of the specification, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the heavy presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).<sup>3</sup>

In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>4</sup>

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<sup>3</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustom meaning . . . .”).

<sup>4</sup> See also MPEP §2111.

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However, if Applicant disagrees with the Examiner and has either (a) already used lexicography or (b) wishes to use lexicography and therefore (under either (a) or (b)) desires a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant in his next response to expressly indicate<sup>5</sup> the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).<sup>6</sup> The Examiner cautions that no new matter is allowed.

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<sup>5</sup> “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

<sup>6</sup> See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.01, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

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Failure by Applicant in his next response to address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant to forgo lexicography in this application and to continue having the claims interpreted with their broadest reasonable interpretation. Additionally, it is the Examiner's position that above requirements are reasonable.<sup>7</sup> Unless expressly noted otherwise by the Examiner, the preceding discussion on claim interpretation principles applies to all examined claims currently pending.

24. Additionally, the Examiner notes that "the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics." *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter "*Atlantic Thermoplastics v. Faytex I*"). Furthermore, the Federal Circuit "acknowledges that it has in effect recognized . . . product-by-process claims as exceptional." 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed claims 1-9 and finds that the claims *do not* contain any product-by-process limitations whether in a conventional

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<sup>7</sup> The requirements are reasonable on at least two separate and independent grounds. First, the Examiner's requirements are simply an express request for clarification of how Applicant intends his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant is not inadvertently overlooked by the Examiner. Second, the requirements are reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed September 2, 2003).

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format or otherwise. If Applicant disagrees with the Examiner, the Examiner respectfully requests Applicant in his next response to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and treated accordingly. Applicant is reminded that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).<sup>8</sup> Failure by Applicant in his next response to also address this issue or to be non-responsive to this issue entirely will be considered intent by Applicant *not* to recite any product-by-process limitations. Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

25. Because Applicant recites “a method . . . comprising the steps of” in independent claim 1 and because the claims dependent upon claim 1 each recite “The method of claim 1, . . .,”<sup>9</sup> the Examiner finds that claims 1-9 are directed to the 35 U.S.C. §101 category of a process.<sup>10</sup> The Examiner makes this finding because it clearly effects claim interpretation.

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<sup>8</sup> See also MPEP §2113.

<sup>9</sup> This same reasoning applies to all subsequent claims dependent upon independent claim 1, whether nested or not, since by statute, a dependent claim incorporates by reference all limitations of the claim to which it refers. See 35 U.S.C. §112 4<sup>th</sup> paragraph.

<sup>10</sup> See 35 U.S.C. §101 (1994) (“Whoever invents or discovers any new and useful process . . . may obtain a patent therefor.”); and 35 U.S.C. §100(b) (1994) (“The term ‘process’ means process, art or method . . .”).

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Specifically, Applicant is reminded that regarding the structural limitations in process claims, “it is generally the rule that patentability of a method claim must rest on the method steps recited, not on the structure used, unless that structure affects the method steps.” *Leesona Corp. v. US*, 530 F.2d 896, 908 (US Ct Clms 1976). In other words, “[t]o be entitled to such [patentable] weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure . . . .” *Ex Parte Pfeiffer*, 135 USPQ 31, 33 (B.P.A.I. 1961).

26. Although Applicant uses “means” in the claim(s) (e.g. claim 1 reciting “a securing means”), it is the Examiner’s position that the “means” phrases do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph.

However, if Applicant desires to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, and Applicant changing the “means” phrases to “means for” phrase(s), the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶*.<sup>11</sup>

Failure by Applicant to address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in the manner set forth above or to be non-responsive to this issue entirely will be considered a desire by Applicant NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner,

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<sup>11</sup> Federal Register Vol 65, No 120, June 21, 2000.

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the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Howard et. al. (U.S. 6,513,017 B1); Porter (U.S. 6,426,699 B1); Kenney (U.S. 6,381,583 B1); Burke (U.S. 6,304,855 B1); Allard et. al. (U.S. 6,249,773 B1); Matsumori (U.S. 6,246,998 B1); Lake et. al. (U.S. 6,155,715); Burke (U.S. 6,026,377); Kenney (U.S. 6,026,376); Burke (U.S. 5,848,399); Mogil et. al. (U.S. D 328,550); Sparks (U.S. 4,037,853); Fullington et. al. (U.S. 3,628,807); Thompson (U.S. 3,237,721); Farls (U.S. 2,710,639); Green (U.S. 2,310,627); Onstott (U.S. 2,301,639); Bingham (U.S. 2,128,689); and Williams (U.S. 1,034,050).

28. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

29. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (e.g. Sone) and expressly noted its content, the other documents now of record were also considered and applied when making the Examiner's factual findings and conclusions of law (see e.g. the 35 U.S.C.

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§112 2<sup>nd</sup> paragraph rejections and prior art rejections above). Moreover, because many of the cannons of claim construction are generally viewed from a person of ordinary skill in the art,<sup>12</sup> the other documents of record not specifically mentioned in the prior art rejections above were nevertheless used in the Examiner's deliberative process to access, *inter alia*, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

30. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will still require further consideration and/or search and a patentability determination as described above.

31. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet

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<sup>12</sup> See e.g. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

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Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these three references are directed towards beginners (see e.g. "User Level: Beginning . . ."), because of the references' basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art now of record in conjunction with the factors as discussed in MPEP §2141.03, the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

32. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant disagrees with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>13</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in their next response*. By

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<sup>13</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.



Andrew J. Fischer  
Patent Examiner

AJF  
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